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09/410,494	09/30/1999	KURT W. PIERSOL	74451.P107	6948

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EXAMINER

WON, YOUNG N

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/410,494

Applicant(s)

PIERSOL ET AL.

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

1. Claims 26-29 have been cancelled, amended claims 1, 3-7, 10, 13, 15-19, 22, and 25 have been examined, and claims 2, 8-9, 11, 12, 14, 20, 21, 23, 24, 30, and 31 have been re-examined.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8, 12-20, 24, 25, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Walls et al. (U.S. Pat. No.5848410).

As per claims 1 and 13, Walls teaches a method (see col.8, lines 5: system and method) comprising and a machine-readable medium having stored thereon sequences of instructions that, when executed by one or more processors (see col.9, lines 39-51), cause: generating, automatically (see col.8, lines 10-11) with an electronic system (see col.9, line 35: network environment and Fig.1), a local network (see col.10, lines 55-62: "intranet" and col.11, lines 57-61) search request (see col.26, lines 25-26: search one or more files...at one or more intervals) in response to an original search request, the local network search request to cause a search to be performed on electronic documents (see col.1, lines 39-42 and col.3, lines 17-18: web page) unconsciously captured (see col.12 line 57 to col.13 line 4) by a local network device (see col.10, lines 15-16: output devices), wherein the unconsciously captured documents are stored by a device that is part of a local network (inherent: any captured document is initially stored in a cache and further may be saved by the user in the user device's memory), the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request (see col.11, lines 25-39); and generating, automatically with the electronic system, an external network (see col.10, lines 52-55: remote and col.11, lines 57-61: Internet) search (see col.26, lines 25-26: search one or more files...at one or more intervals) request in response to the original search request, the external network search request to cause a search to be performed on electronic documents available from devices that are part of an external network via a network portal (see col.10, lines 23 & 36: network interface) of an external network (see col.1, lines 26-29: Internet) according to the search parameters of the original search request.

As per claims 2 and 14, Walls further teaches wherein the local network device comprises a file management appliance (see col.3, lines 52-55: continuous indexer).

As per claims 3 and 15, Walls further teaches wherein the file management appliance generates the local network search request and the external network search request (see col.3, line 64, to col.4 line 2: at least; and col.11, lines 23-25 & 35-39).

As per claims 4 and 16, Walls further teaches wherein the file management appliance performs a search of the unconsciously captured electronic documents in response to the local network search request (see col.12, line 57 to col.13, line 4).

As per claims 5 and 17, Walls further teaches an Internet portal (see col.10, line 40: Internet, and Fig.1, no.150) performs a search of the electronic documents available via a network portal (see col.10, lines 23 & 36: network interface, and Fig.1 no.128) of an external network in response to the external network search request.

As per claims 6 and 18, Walls further teaches wherein the local network search request, and the external network search request, are generated by a portal appliance (see col.3, lines 52-55: continuous indexer) in response to the original search request.

As per claims 7 and 19, Walls further teaches generating a single search report (see col.28, lines 12-15) based on results from the local network search request and the external network search request (see. col.5, lines 49-52).

As per claims 8 and 20, Walls further teaches wherein the search report is a Hypertext Markup Language (HTML) document (see col.1, lines 29-32 & 59-62; col.4, lines 23-24; and col.12, lines 29-30).

As per claims 12 and 24, Walls further teaches generating a third search request in response to the original search request, the third search request (see col.26, lines 25-26: search one or more files...at one or more intervals) to cause a search to be performed on electronic documents available via a second network portal (see col.10, lines 37-39, nodes may consist of more host servers, whereby in lines 35-36, include via a network interface) of the external network according to the search parameters of the original search request.

As per claim 25, Walls teaches of an apparatus comprising: a device (see col.10, lines 10-14) to automatically (see col.8, lines 10-11) capture electronic documents from a local network (see col.4, lines 20-21); and an application (see col.9, lines 39-51) to be executed by the device (see col.9, line 67 to col.10, line 4) to search the captured electronic documents (see col.1, lines 39-42 and col.3, lines 17-18: web page) in response to a search request, wherein the application also generates an external document search request (see col.11, lines 57-61) in response to the search request, wherein the device transmits the external document search request to a device on an external network, wherein the device on the external network performs (see col.25, lines 58-61) the external document search request to generate a search of electronic documents from an external network (see col.1, lines 26-29: Internet).

As per claims 30 and 31, Walls further teaches wherein external document search is performed by an Internet portal (see col.10, line 40: Internet, and Fig.1, no.150) and wherein the search of captured electronic documents is performed by the device (see col.10, lines 24-34).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of MacKenty et al. (U.S. Pat. No.6088675). Walls teaches all the limitations of claims 9 and 21, except that the search report is an Extensible Markup Language (XML) document. MacKenty teaches that a report can be an Extensible Markup Language (XML) document (see col.1, lines 19-21). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of MacKenty within the system of Walls, by using XML documents within the search report, because XML documents are used for technical documentations. Thus, if technical searches were widely performed, one would employ an XML document as the standard.

4. Claims 10, 11, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of Rakavy et al. (U.S. Pat. No.5913040). Walls teaches all the limitations of claims 10, 11, 22, and 23, except that the search report comprises an advertisement selected based on the external network search request and based on analysis of documents indicated by search results. Rakavy teaches of a search report comprises an advertisement selected based on the external network ("Internet") search request and based on analysis of documents indicated by search results (see col.1, lines 20-22 & 35-42). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of Rakavy within the system of Walls, by employing search reports comprising an advertisement generated from search results, because this would allow searching systems like Walls' to generate revenue from companies who wish to advertise to customers using such systems, in similar fashion to web site advertising methods currently employed.

#### ***Response to Remarks***

5. Applicant's arguments filed June 23, 2003 have been fully considered but they are not persuasive.

In response to the arguments regarding claims 1, 13, and 25, clearly Walls is teaching that the searching may be performed in the Internet, intranet, or both. The use



of “or” is to merely teach of the different networks that may be employed within the system of Walls’. By no means is Walls limiting his system that if the Internet is searched, the intranet cannot be searched and vice versa. Contrary to the argument, Walls further teaches that “The continuous indexer is configured to search one or more files within **at least** one file system at one or more intervals to provide a user with a continuous...” (see col.3, lines 52-55). The translation of “the at least one or more file systems includes files in a network” (col.4, lines 20-22) does not in any way suggest a “single network”, but Walls is merely disclosing the user-selected available conditions (see col.4, lines 14-35).

Additionally, Walls teaches of “capturing of electronic documents” (see abstract, 1<sup>st</sup> sentence and col.25, lines 62-64).

In regards to the remarks of claims 9 and 21, the limitation of a “search report” is taught by Walls (see col.28, lines 13-16).

### ***Conclusion***

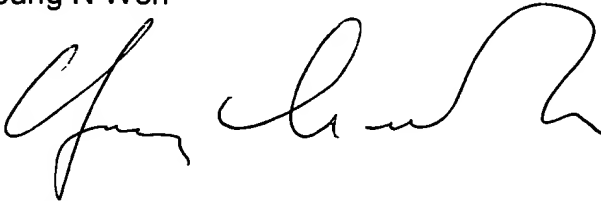
It is highly suggested, in overcoming all prior art, to amend the claims to explicitly teach the applicant’s invention. Whatever is not taught by the primary reference, may be taught by a secondary reference, and without a clearly defined claim, the motivation to combine references is more readily apparent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



August 4, 2003



HOSAIN T. ALAM  
PRIMARY EXAMINER